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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/715.013	11/20/2000	Keunsuk P. Chang	361752000500	7915

25227 7590 12/22/2003  
MORRISON & FOERSTER LLP  
1650 TYSONS BOULEVARD  
SUITE 300  
MCLEAN, VA 22102

EXAMINER
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FERGUSON, LAWRENCE D

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 12/22/2003

## Office Action Summary

**Application No.**

09/715,013

**Applicant(s)**

CHANG ET AL.

**Examiner**

Lawrence D Ferguson

**Art Unit**

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 03 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20, 24-44 and 46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20, 24-44 and 46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is in response to the amendment mailed September 3, 2003.

Claims 1-20, 24-44 and 46 are pending.

### ***New Matter - 35 U.S.C. 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 3, 25 and 27, amended on February 26, 2003, are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The phrase, 'substantially free from slip additives' is not supported by the instant specification. Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections – 35 USC § 103(a)***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-8 and 10-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) as previously stated in the Office Action submitted on June 13, 2003. Regarding the limitation of 'wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film' under 9% elongation includes zero, which is met by Tsuchiya.

***Claim Rejections – 35 USC § 103(a)***

6. Claims 9, 17-18, 33 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Kurokawa et al (U.S. 5,698,317) as previously stated in the Office Action submitted on June 13, 2003.

***Claim Rejections – 35 USC § 103(a)***

7. Claims 19-20 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Tanizaki et al (U.S. 5,998,039) as previously stated in the Office Action submitted on June 13, 2003.

***Claim Rejections – 35 USC § 103(a)***

8. Claims 24 and 46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Yokoyama et al (U.S. 5,939,205) in

further view of Akao et al. (U.S. 5,492,741) as previously stated in the Office Action submitted on June 13, 2003.

***Claim Rejections – 35 USC § 103(a)***

9. Claims 25-32 and 34-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) in view of Yokoyama et al (U.S. 5,939,205) as previously stated in the Office Action submitted on June 13, 2003. Regarding the limitation of 'wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film' under 9% elongation includes zero, which is met by Tsuchiya.

***Response to Arguments***

10. Applicant's remarks to 35 USC 103(a) as being unpatentable over Tsuchiya et al. (U.S. 5,137,955) have been considered but are unpersuasive. Applicant argues Tsuchiya does disclose slip agents even if the reference does not use the words "slip agent" to describe them. Regarding added limitation of 'a polyolefin resin layer substantially free from slip additives,' amended on February 26, 2003, the phrase, 'substantially free from slip additives' is not supported by the instant specification. The specification lacks a definition for "substantially free." Substantially free can mean a small amount of slip additive, as is disclosed in the Tsuchiya reference. Applicant further argues the claim language '...wherein said discharge-treated surface is formed in an

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atmosphere consisting essentially of CO<sub>2</sub> and N<sub>2</sub> to form said nitrogen functional groups and wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film' refers to said nitrogen functional groups. The nitrogen content does not rely on the steps by which the nitrogen functional groups are provided; however, the forming of the discharge-treated surface is a product-by-process limitation, as was indicated in the previous rejection. As indicated in the rejection of July 17, 2002, such percentages of nitrogen functional groups is a property which can easily be determined by one of ordinary skill in the art. With regard to the limitation of the nitrogen content percentage, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. nitrogen content percentage) fails to render claims patentable in the absence of unexpected results. Applicant further argues the limitation of 'wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film' is not a product by process claim limitation. Regarding the limitation of 'wherein the laminate film has a barrier durability under 9% elongation of 46.5 cc/m<sup>2</sup>/day or less oxygen transmission rate through the laminate film' under 9% elongation includes zero, which is met by Tsuchiya.

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**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is (703) 305-9978. The examiner can normally be reached on Monday through Friday 8:30 AM – 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on (703) 308-0449. Please allow the examiner twenty-four hours to return your call.

The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2351.



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA M. KELLY  
SUPERVISOR  
ART UNIT 1774  
SEP 17 2009

